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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/553,898

10/21/2005

Shusaku Takagi

05702/HG

9904

1933 7590 12/08/2008
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EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/553,898 | Applicant(s) TAKAGI ET AL. | |
| | Examiner CAITLIN FOGARTY | Art Unit 1793 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/4/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1 – 8 are pending where claims 1 and 5 have been amended.

Status of Previous Rejections

2. The 35 U.S.C. 103(a) rejection of claims 1 – 8 as being unpatentable over JP 2002-226937 has been maintained.

Information Disclosure Statement

3. The information disclosure statement (IDS) was submitted on September 4, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2002-226937 from the IDS (hereafter JP '937).

JP '937 is applied to instant claims 1 – 8 as set forth in the March 18, 2008 Office action.

With respect to the amended feature of instant claims 1 and 5, [0009] of JP '937 discloses that the high tensile cold-rolled steel sheet may have a composition with a maximum of 0.02 mass% Al which is within the amended instant aluminum range of 0.02-0.07 mass% Al.

Since the claimed compositional ranges of claims 1 – 8 either overlap or are within the ranges disclosed by JP '937, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed cold-rolled steel sheet composition from the cold-rolled steel sheet composition disclosed by JP '937 because JP '937 teaches the same utility (i.e. the structural components of an automobile) in the whole disclosed range.

Response to Arguments

6. Applicant's arguments filed September 4, 2008 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

- a. JP '937 does not disclose that the cold-rolled steel sheet has 0.85-1.5 of a ratio of intervals of the martensite in the rolling direction to those in the sheet thickness direction.
- b. JP '937 does not teach the formula of the annealing temperature range recited in instant claim 5. All the specific examples in Table 3 of JP '937 do not fulfill the annealing temperature range of applicants' present claim 5.

Examiner's responses are as follows:

- a. In absence of evidence to the contrary, the Examiner maintains the position that since the steel sheet of JP '937 is made using essentially the same process as the instant invention and has an overlapping composition with the

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steel sheet of the instant invention, it would be expected that the steel sheet of JP '937 would inherently have the recited ratio. See MPEP 2112.

b. The scope of JP '937 is not limited to the specific embodiments it teaches. (see *In re Fracalossi* 215 USPQ 569 (CCPA 1982)). Therefore, the Examiner maintains the position that the annealing temperature range of 650-950°C disclosed by JP '937 encompasses the specific examples of annealing temperature ranges recited in Table 2-2 of the instant application and therefore JP '937 teaches annealing temperatures that satisfy the formula recited in claim 5 since JP '937 also teaches an overlapping coiling temperature and cold-rolling reduction percentage. Furthermore, Table 6 Steel No. 22, 24, and 25 fulfill the annealing temperature range of applicants' present claim 5.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

CF

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